one end to the other, and deforming the workpiece to form a vehicle frame component. The unique aspect of this invention is that the heat treatment process is performed on the workpiece in a continuous and longitudinal manner. This is contrasted with the prior art method, wherein the heat treatment process is performed in an essentially static condition relative to the workpiece. In other words, although it is known to perform a heat treatment process, such as a retrogression heat treatment process, on a closed channel structural member, either in whole or in part, it is not known to perform such a heat treatment process in a continuous and longitudinal manner, such as shown in the drawings and discussed in the specification.

The Examiner stated that "official notice is taken that the concept of heat treating a workpiece with a device, in this case an inductive heating coil and a quenching ring, either in a stationary manner or in a continuous manner relative to the workpiece is notoriously old and well known throughout the art ..." (emphasis added). Respectfully, it is submitted that emphasized portion of this statement is wholly unsupported in the record. Neither the specification nor any source of prior art has been cited by the Examiner in support of this conclusion of obviousness. The Examiner is respectfully requested to identify any teaching in any prior art in support of this position. Absent any such teaching, the rejection must be withdrawn.

The Examiner's attention is drawn to In Re Sang-Su Lee, a decision of the Court Of Appeals For The Federal Circuit dated January 18, 2002. In that decision, the Court overturned a decision of the Board Of Patent Appeals And Interferences based upon obviousness. In its decision, the Board had stated:

> "The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference."

The Court overturned this decision, stating that:

> "As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, [citations omitted]. The essential factual

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> evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, [citations omitted] and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.,* [citations omitted]"

The Court continued, stating that:

> "The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, [citations omitted] ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an `essential component of an obviousness holding'") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, [citations omitted]; *In re Dembiczak*, [citations omitted] ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, [citations omitted] (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, [citations omitted] ("`teachings of references can be combined *only* if there is some suggestion or incentive to do so.'") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, [citations omitted].

Thus, it is clear that burden is on the Examiner to identify an objective teaching contained in any of the art of record in support of the conclusion of obviousness of the claimed invention. Absent such teaching, the rejection must fail.

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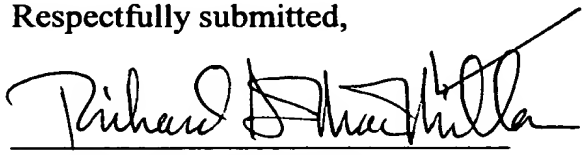
In view of the above remarks, it is believed that the application is in condition for allowance. Accordingly, an early Notice Of Allowance is respectfully requested.

Respectfully submitted,



Richard S. MacMillan
Reg. No. 30,085

MacMillan, Sobanski & Todd, LLC
One Maritime Plaza, Fourth Floor
720 Water Street
Toledo, Ohio 43604
(419) 255-5900

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